

90. The system of claim 57, wherein said intermediate station further comprises:  
an acknowledgment circuit adapted to produce an acknowledgment of receipt  
of said transmitted information.

### **Remarks**

#### **I. General**

Claims 1-28, 31-78, and 80-90 are currently pending in the present application. Claims 1-28, 31-78, and 80-90 stand rejected under 35 U.S.C. § 103. Claims 57-74 and 90 stand rejected under 35 U.S.C. § 112, second paragraph. Claim 80 stands objected to as including informalities.

By Advisory Action mailed July 7, 2000 the Examiner has indicated that claims 57-74 and 90 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claims. Accordingly, Applicants have canceled rejected claims 1-28, 31-56, 75-78, and 80-89 without prejudice by this Amendment.

#### **II. The 35 U.S.C. § 112 Rejections**

Claims 57-74 and 90 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which application regards as the invention. Specifically, the Office Action asserts that the recital of "said transmitting means" in independent claim 57 lacks antecedent basis in the claim. In response Applicants have amended claim 57 to properly recite "said transmitting station" for which proper antecedent basis is provided in the claim. No new matter has been added.

### III. The 35 U.S.C. § 103 Rejections

Claims 57-66, 70-74, and 90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Albal*, patent number 5,826,034 (hereinafter *Albal*), in view of *Sundsted*, patent number 5,999,967 (hereinafter *Sundsted*), and further in view of *Berkowitz et al.*, patent number 5,903,877 (hereinafter *Berkowitz*). Claims 67-69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Albal* in view of *Sundsted* further in view of *Berkowitz* and further in view of *Maxwell*, patent number 5,805,810 (hereinafter *Maxwell*).

To establish a *prima facie* case of obviousness, three basic criteria must be met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the second criteria, Applicants respectfully assert that the references lack proper motivation to combine in addition to lacking all the claim limitations.

In rejecting independent claim 57 the Examiner concedes that *Albal* does not teach a reproducing circuit producing an indicia of payment authorizing delivery of the human readable information to the selected location. Accordingly, the Examiner relies upon the disclosure of *Sundsted* to modify the system of *Albal* in order to meet the claim. Specifically, the Examiner asserts that *Sundsted* discloses a system which delivers information to a selected location from a transmitting location, wherein an intermediate station comprises a reproducing circuit which produces an indicia of payment authorizing delivery of the human readable information to the selected location.

However, Applicants respectfully assert that *Sundsted* is not properly available as prior art with respect to the rejected claims. Applicants point out that *Sundsted*, available only as a 35 U.S.C. § 102(e) type reference, was filed August 17, 1997. Applicants have attached hereto, as evidence of prior invention, the Declaration Under 37 C.F.R. § 1.131 of Martin J. Pagel showing conception of the present invention prior to a time just before the filing date of *Sundsted* coupled with diligence to the filing date, October 17, 1997, of the

present application. Accordingly, it is respectfully asserted that the rejections of record relying upon the disclosure of *Sundsted* should be withdrawn.

Moreover, a review of *Sundsted* reveals that the system disclosed therein provides a sender side apparatus which sends electronic mail and an attached electronic stamp directly to a receiver side apparatus without an intermediate station, column 9, lines 50-51.

Accordingly, “[w]hen the time comes to create an electronic stamp, the sender side apparatus withdraws an electronic token from the sender’s bank account [which] action decreases the sender’s account balance,” column 9, lines 45-48. In operation of the sender side apparatus, the apparatus requests the electronic token from the bank and places the electronic token in the token field of the electronic stamp, column 10, lines 12-15. Thereafter, “[t]he receiver side apparatus . . . removes the electronic stamp from the electronic mail, and then decrypts and decodes the electronic token [and] deposits the electronic token in the receiver’s bank account,” column 9, lines 53-56. It is the electronic stamp, of which the electronic token provided by the bank is a portion, which authorizes delivery of the electronic mail of *Sundsted*, column 5, lines 41-43.

Claim 57 recites a system wherein an intermediate station comprises:  
a converter circuit adapted to electronically receive said transmitted information [from the transmission station] . . . and  
a reproducing circuit adapted to reproduce said information in human readable form, wherein said reproducing circuit also produces an indicia of payment authorizing delivery of said human readable information to said selected location.

*Sundsted* does not teach an intermediate station providing the production of an indicia of payment authorizing delivery as recited in the claim. Instead, as shown above, *Sundsted* teaches that the electronic stamp authorizing delivery is produced by the sender side apparatus using, as one field of the electronic stamp, an electronic token received from a bank. Accordingly, the proffered combination does not meet the claim and, therefore, does not establish a *prima facie* case of obviousness under 35 U.S.C. § 103 with respect to claim 57 or the claims dependent therefrom.

Moreover, *Sundsted* does not teach an intermediate station whatsoever, but rather teaches an extrinsic node providing accounting services to the sender side apparatus and the receiver side apparatus. Accordingly, even ignoring the above identified differences in the

applied reference and the claim, if one of ordinary skill in the art were to combine the teachings of *Sundsted* with that of *Albal*, the present invention would not result. There is no hint or suggestion provided by the references to modify the payload delivery system of *Albal* to provide the accounting services of *Sundsted* in derogation of the extrinsic node accounting method of operation of *Sundsted*. Accordingly, the proffered combination does not teach all elements of the claim and, therefore, is insufficient to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 with respect to claim 57 and the claims dependent therefrom.

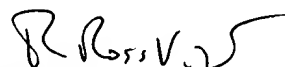
Additionally, Applicants respectfully assert that the Examiner has not properly established a *prima facie* case of obviousness with respect to combining *Albal*, *Sundsted*, and *Berkowitz*. Specifically, the Examiner proffers as motivation to combine *Berkowitz* with *Albal* and *Sundsted* that “*Albal*’s system could be easily be adapted to include *Berkowitz*’s converter circuit, as the systems share cumulative features, therein making *Albal*’s system easily modifiable to a person of ordinary skill in the art.” As discussed above, Applicants respectfully assert that the ease by which modifications may or may not be made is irrelevant to the question of obviousness under 35 U.S.C. § 103. Consistent with this the Manual of Patent Examining Procedure provides that “[t]he level of skill in the art cannot be relied upon to provide the suggestion to combine references.” M.P.E.P. § 2143.01 (citing *Al-Site Corp. v. VSI Int’l Inc.*, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999)). Accordingly, even if it were assumed arguendo that “*Albal*’s system could be easily be adapted to include *Berkowitz*’s converter circuit” this simply does not provide the requisite motivation required under 35 U.S.C. § 103 as this statement says nothing more than the references can be combined. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, M.P.E.P. § 2143.01, citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

**III. Summary**

As shown above, there are great differences between the claims and the prior art. Moreover a person of ordinary skill in the art considering the prior art would not find these differences obvious. Accordingly, Applicants respectfully traverse the Examiner's 35 U.S.C. § 103 rejections of record. Therefore, Applicants respectfully request that the claims be passed to issue.

Applicant respectfully requests that the Examiner call him at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,



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